



Please place a plus sign (+) inside this box ☒

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PTO/SB/21 (12-97)
Approved for use through 9/30/00. OMB 0651-0031
Patent and Trademark Office: U.S. Department of Commerce

TRANSMITTAL FORM (To be used for all correspondence after initial filing)	Application Number	09/786,926
	Filing Date	May 4, 2001
	First Named Inventor	Markus Graler
	Group Art Unit	1647
	Examiner Name	Bridget E. Bunner
Total Number of Pages in This Submission	Attorney Docket Number	101195-45

RECEIVED

OCT 11 2002

TECH CENTER 1600/2901

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Assignment Papers (for an Application)	<input type="checkbox"/> After Allowance Communication to Group
<input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input checked="" type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Petition	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> To convert a Provisional Application	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input checked="" type="checkbox"/> Additional Enclosure(s) -(please identify below): return receipt postcard
<input type="checkbox"/> Certified Copy of Priority Document(s)	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Response to Missing Parts/ Incomplete Application	<input type="checkbox"/> Small Entity Statement	
<input checked="" type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Request for Refund	
Remarks:		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Theodore A. Gottlieb NORRIS McLAUGHLIN & MARCUS, P.A.
Signature	 Reg. No. 42,597
Date	October 1, 2002

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to : Hon. Assistant Commissioner of Patents, Washington, D.C. 20231.

Typed or printed name	Vilma I. Fernandez		
Signature		Date	October 1, 2002

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Hon. Commissioner of Patents, Washington, DC 20231.



#12B
12B
10/16/02

Atty's Docket No. 101195-45

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to the Assistant Commissioner For Patents, Washington, D.C. 20231, on October 1, 2002.


Vilma I. Fernandez

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

RECEIVED
OCT 11 2002
TECH CENTER 1600/2900

APPLICANT : Markus Graler et al.
Serial No. : 09/786,926
FILED : May 4, 2001
EXAMINER : Bridget E. Bunner
ART UNIT : 1647
FOR : Human and Murine G-protein-coupled Edg6 Receptor (Endothelial Differentiation Gene) and Use of Same

RESPONSE TO RESTRICTION REQUIREMENT AND
ONE MONTH EXTENSION OF TIME

Hon. Assistant Commissioner of Patents
Washington, D.C. 20231

October 1, 2002

Sir:

This communication is in response to the Office Action of August 19, 2002.

Entry of the amendments and consideration of the remarks is respectfully solicited.

IN THE CLAIMS

Amend claims 1 and 2 as follows:

- B1
1. (Amended) The G-protein coupled receptor EDG6 of claim 21, having a sequence according to SEQ ID NO 1.
 2. 2. (Amended) The G-protein coupled receptor EDG6 of claim 21, having a sequence according to SEQ ID NO 4.

Add new claim 21 as follows:

- B2
21. (amended) A mammalian G-protein coupled receptor EDG6 selected from the group consisting of SEQ ID NO 1 and SEQ ID NO 4.

add C2

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 1-20 are in the application. The claims have been subjected to a 7-way restriction requirement.

Applicants elect Group I, comprising claims 1, 3-4, and 12-13 with traverse. Specifically, Applicants respectfully request that the restriction between Groups I and II be withdrawn in view of the following remarks.

Examiner's rationale for the above restriction is that, e.g., Group I and Group II "lack the same or corresponding special technical features." The only basis for this conclusion is that Group I is to a human receptor and Group II is to a murine protein. Further, it is asserted that the technical features of Group I and II are not "required by the other products." In other words, the murine and human receptor do not share technical features that are required by both receptors.

Applicants hereby traverse the restriction requirement and respectfully urge reconsideration and withdrawal of the restriction between Groups I and II. Applicants respectfully disclose why it is believed that Examiner's rationale for this restriction is incorrect and is apparently predicated on an improper definition of the phrase *special technical feature*.

ANNEX B of the PCT defines special technical features under PCT Rule 13.2 as "those technical features that define a contribution which each of the inventions, considered as a whole, makes over the prior art." MPEP, p. A1-53 (Emphasis added). Further, "the determination is made on the contents of the claims as interpreted in light of the description and drawings." Id. (Emphasis added). It is respectfully suggested that Examiner has not followed these guidelines.

The main basis for Examiner's restriction of Groups I and II is that they are derived from different organisms, human and mouse.

Being derived from mouse and human is NOT a special technical feature under PCT practice. Under PCT practice, a technical feature relates to the elements of the physical embodiments of the inventions. Thus, the restriction requirement between Groups I and II is improper on its face and should be withdrawn.

In addition, the specification and drawings indicate that the proteins of SEQ IDS NO 1 and 4 have virtually identical biological and biochemical properties and at least 88% identity of structure.

For example Figure 1 shows the transmembrane disposition of the receptor. The orientation of a membrane protein is known in the art, to be attained spontaneously during the nascent peptide's cotranslational insertion through the lipid bilayer of the endoplasmic reticulum. This orientation must be attained by both human and mouse because of [a] the high degree of structural similarity, and [b] the necessity of this orientation to act as a G-protein coupled signal transducer. Thus, e.g., extracellular and cytoplasmic domains of the human and mouse proteins are involved in the recognizing and transducing the same signals across the plasma membrane.

Further, Applicants point out on page 3, 3rd paragraph, that a homology search based on the human cDNA sequence indicated the existence of a previously reported partial cDNA (i.e., EST). This incomplete sequence was of murine origin, and showed 88%

homology to the human sequence of SEQ ID NO 2. This partial sequence was used to obtain the full length murine cDNA and translated sequence of SEQ ID NOS 3 and 2 respectively.

Applicants further disclose on page 4, 3rd paragraph, that the receptor has high homology with the human receptor. Thus, there are several technical features manifested and shared between the claims of Group I and II . These features have been evolutionarily conserved as indicated by the fact that these proteins demonstrate the same tissue-specific pattern of expression in mouse and human tissues. Id.

Accordingly, the mouse and human receptors are almost identical in structure, function and tissue specificity. It is wholly improper to ignore these disclosures to determine the presence of special technical features, and instead, rely merely on their species of origin.

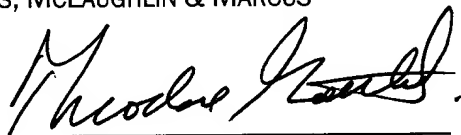
CONCLUSION

In sum, Applicants respectfully suggest that in view of the foregoing remarks Examiner is fully justified in withdrawing the restriction requirement as applied to Group I and Group II.

Applicants have added new claim 21 as a proper generic claim to claims 1 and 2, and thus, Groups I and II.

Applicants respectfully request that the claims are in condition for allowance.

Respectfully submitted,
NORRIS, McLAUGHLIN & MARCUS

A handwritten signature in black ink, appearing to read 'Theodore A. Gottlieb', is written over a horizontal line.

Theodore A. Gottlieb, Ph.D.
Reg. No. 42,597
220 East 42nd Street
New York, NY 10017
telephone (646) 487-5675
facsimile (212) 808-0844

MARK-UP OF AMENDED CLAIMS

1. (Amended) The Human G-protein coupled receptor EDG6 of claim 21, having a sequence with the according to SEQ ID NO 1 ~~sequence 1 as well as its fragments, variants and mutations.~~
2. 2. (Amended) The Murine G-protein coupled receptor EDG6 of claim 21, having a sequence according to SEQ ID NO 4 ~~sequence 1 as well as its fragments, variants and mutations.~~